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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,875	05/14/2002	Jay A Fournier	021238-503	8681

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EXAMINER

WALLS, DIONNE A

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 07/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/031,875

Applicant(s)

FOURNIER ET AL.

Examiner

Dionne A. Walls

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1) ☐ Certified copies of the priority documents have been received.  
2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1- 27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,289,898. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims containing recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. in "an electrical smoking system") does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (see MPEP 2114 – which applies equally to "article" claims).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,3, 5-6, 14, 18, 21, 24, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by McCarty et al (US. Pat. No. 3,744,496).

McCarty et al discloses all that is recited in the claims (see entire document, specifically col. 2, lines 9-55, col. 4, lines 28-29; table 4; see abstract. Note: Claims containing recitation with respect to the manner in which a claimed apparatus is intended to be employed (i.e. in "an electrical smoking system") does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim (see MPEP 2114 – which applies equally to "article" claims). Therefore, the "intended use" requirement, in the instant claims, reciting that the product is for use in "an electrical smoking system" would have been inherent in the wrapper of McCarty et al since said wrapper can be wrapped around a cigarette, which is then capable of being used in such a system.)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7-11 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al (US. Pat. No. 3,744,496).

Regarding claims 7-8, in the examples of McCarty et al, the wrapper of its invention has a basis weights of around 60 g/m<sup>2</sup>. McCarty also discloses that the porosity of its wrapper can be tailored to fit the requirements of the finished cigarette (see cols. 3-4). While McCarty may not explicitly disclose, exactly, the claimed basis weight and porosity parameter combinations, it would have been obvious to one having ordinary skill in the art at the time of the invention to discover these parameters, after minimal experimentation, in order to arrive at a wrapper having optimal burn characteristics.

Regarding claims 9-11, McCarty et al may discloses that (while not required) burn additives, such as alkali metal carbonates, can be utilized. And while the salts listed in claim 11 may not specifically be articulated, McCarty does state that citrates, phosphates or nitrates can be used. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to utilize one of the alkali metal salts claimed since these are few of several well known burn promoters in the tobacco art.

Regarding claim 19, while McCarty et al may not disclose that the gaseous component whose content is reduced by the presence of the filler during combustion of the smoking article includes at least aldehyde, McCarty et al does suggest that major organic vapor phase yield is greatly reduced (col. 4, lines 56-64). This would suggest to one of ordinary skill in the art that aldehyde, which is an organic vapor phase component, is also reduced (at least to some extent) due to the presence of the particular filler material in the cigarette wrapper of McCarty.

6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over McCarty et al (US. Pat. No. 3,744,496) in view of Baldwin et al (US. Pat. No. 5,263,500).

While McCarty et al may not disclose the wrapper being perforated, it does state that the porosity of the wrapper may be tailored to fit the requirements of the finished cigarette, such as the air dilution of the smoke desired. Further, Baldwin et al states, in its "Background of the Invention", that the relationship of paper porosity to cigarette performance is well known. Specifically, if paper porosity is increased via perforations of the paper, then puff count increases and tar per puff decreases due to air dilution (see col. 1, lines 20-30). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to perforate the wrapper of McCarty et al in order to allow sufficient air to the fuel source so as to sustain combustion, while at the same time decreasing tar inhaled, per puff.

#### ***Allowable Subject Matter***

7. Claim 26 would be allowed, upon the filing of a Terminal Disclaimer.

8. Claims 2, 4, 12-13, 15-17, 22-23, and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and if a Terminal Disclaimer is filed.

#### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


- Muller (US. Pat. No. 2,128,782)

- Fournier et al (US. Pat. No. 6,289,898)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

  
Dionne A. Walls  
July 2, 2003